

Applicants: Andrzej Lipkowski et al.
Serial No.: 10/524,343(a §371 of PCT PCT/PL2003/000077)
Filed : January 30, 2006
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REMARKS

Claims 1-16 were pending in the subject application. By this Amendment, applicants have amended the claims as indicated above. Accordingly, claims 2-3, 5-9 and 11-16 are pending in the subject application.

Restriction Requirement

In the March 5, 2007 Restriction Requirement, the Examiner required restriction to one of the following allegedly distinct inventions as follows:

- I. Claims 1-9, drawn to compounds and pharmaceutical compositions; and
- II. Claims 10-16, drawn to methods of alleviating pain.

The Examiner alleged that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because the compounds of claim 1 purportedly have been reported in Lipkowski et al., Biorg. Med. Chem. Let., 1999, 9, 2763-6, Figure 1 and Table 1.

The Examiner also alleged that this application contains claims directed to more than one species of the generic invention and required applicants, in reply to this action, to elect a single

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species to which the claims shall be restricted if no generic claims is finally held to be allowable, and to identify the claims readable on the elected species, including any claims subsequently added. The Examiner stated that claims 1-16 are generic.

The Examiner indicated that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. MPEP §809.02(a).

Applicants' reply

In response, applicants elect, with traverse, Group I, i.e. pending claims 2, 3 and 5-9.

In addition, applicants elect the species defined by the formula: (Tyr-D-Met-Gly-Phe-NH-)₂. Each of elected claims 2, 3 and 5-9 reads on the elected species.

However, Applicants traverse the requirement for restriction on the basis that the claims of purported Group I and of purported Group II have a common inventive concept in compliance with 37 C.F.R. §1.475(b)(2), which requires examination in the same application of a "product and a process of use of said product."

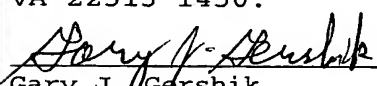
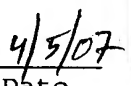
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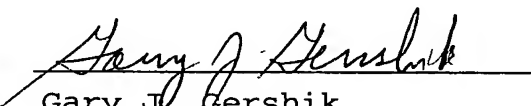
Accordingly, the restriction between the claims of purported Groups I and II is improper under 37 C.F.R. §1.475.

Furthermore, the requirement for election of species is improper in view of the guidance of the PCT Administrative Instructions, Annex B, section (f), which provides that members of a Markush group having "a common property" be examined in the same application.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
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